



DEC 14 2001
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Charles A. Muserlian
Bierman, Muserlian and Lucas
600 Third Avenue
New York, NY 10016

In re Application of	:	
DUBOIS	:	DECISION ON
Application No.: 09/202,217	:	
PCT No.: PCT/FR97/01023	:	RENEWED PETITION
Int. Filing Date: 10 June 1997	:	
Priority Date: 11 June 1996	:	UNDER 37 CFR 1.47(b)
Attorney's Docket No.: 146.1307	:	
For: NEW DEVICES INTENDED FOR THE	:	
TRANSDERMIC ADMINISTRATION OF	:	
TRIMEGESTONE, THEIR PREPARATION	:	
PROCESS AND THEIR USE AS MEDICAMENTS	:	

This decision is in response to applicant's "RENEWED PETITION UNDER RULE 47" filed 23 July 2001.

BACKGROUND

On 10 June 1997, applicant filed international application PCT/FR97/01023, which claimed a priority date of 11 June 1996. A copy of the international communication was communicated to the United States Patent and Trademark Office from the International Bureau on 18 December 1997. A Demand for international preliminary examination in which the United States was elected, was filed on 31 December 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 December 1998.

On 09 December 1998, applicant filed, in the United States Patent and Trademark Office (USPTO), a transmittal letter requesting entry into the U.S. national stage, which was accompanied by, *inter alia*, the requisite U.S. basic national fee.

On 21 September 1999, applicants filed a PETITION UNDER RULE 42. The petition was accompanied by: the petition fee; a declaration of Jean-Claude Vieillefosse setting forth facts entitled DECLARATION UNDER RULE 47 (hereinafter "first declaration of facts"); a declaration of Mr. Vieillefosse on behalf of and as agent for the non-signing inventor; and Exhibits A-F:

- Exhibit A, a declaration of designation of inventors signed by Mr. Dubois;
- Exhibit B, copy of French law;
- Exhibit C, copy of employment contract;
- Exhibit D, copy of letter written to Mr. Dubois on 09 November 1998;
- Exhibit E, copy of fax to Mr. Dubois sent on 02 December 1998; and
- Exhibit F, copy of letter forwarded to Mr. Dubois on 30 December 1998.

However, Exhibits A and D-F were not in the application file. Additionally, the listing of "Enclosures" in the petition did not include the documents corresponding to Exhibits A and D-F.

On 27 October 1999, the USPTO mailed applicants a NOTIFICATION OF MISSING REQUIREMENTS (PCT/DO/EO/905) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (PCT/DO/EO/917) which indicated that the oath or declaration was not properly executed, and set a one month time period for response.

On 04 November 1999, applicant filed a RESPONSE to the NOTIFICATION OF MISSING REQUIREMENTS stating that a petition under Rule 42 was filed on 21 September 1999. The RESPONSE included a postcard receipt. Note that this postcard receipt did not list the items which comprised Exhibits A and D-F.

On 09 March 2000, the USPTO mailed a decision indicating that the petition under 37 CFR 1.42 was dismissed because an oath or declaration by the legal representative of the deceased inventor had not been presented. The decision also discussed the petition and supporting documentation as it related to 37 CFR 1.47(b) for petitioner's information only.

On 06 April 2000, applicants filed a RENEWED PETITION UNDER 37 CFR 1.47(b). The renewed petition was accompanied by a second declaration of facts (hereinafter "second declaration of facts") by Jean-Claude Vieillefosse and purportedly Exhibits A and D-F, which were missing from the submission of 21 September 1999. The sheet marked Exhibit A, however, is not a declaration of designation of inventors signed by Mr. Dubois but is rather an attestation certifying that Mr. Dubois was an employee of Hoechst Marion Roussel from 02 September 1985 to 31 December 1997. (It is also noted that Exhibits D and E were mislabeled.) English translations of Exhibits D-F were also provided. The renewed petition was also accompanied by an "Extract from the minutes of the Board of Executive Directors' deliberations dated Thursday 10 December 1998 at 2:00PM" and an English translation thereof.

On 27 July 2000, the USPTO mailed a decision dismissing applicants renewed petition under 37 CFR 1.47(b). Specifically, it was noted that factual proof that the inventor refuses to execute the application and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had not been provided.

On 14 June 2001, applicant submitted a facsimile transmission, which was treated as a petition under 37 CFR 1.181. The petition requested that the documents including, *inter alia*, the

"RENEWED PETITION UNDER 37 C.F.R. 1.47(b)" submitted with the petition under 37 CFR 1.181 be accepted as having been filed with the USPTO on 18 December 2000. The submission was accompanied by, *inter alia*, a copy of the "RENEWED PETITION UNDER 37 C.F.R. 1.47(b)"; a copy of a request for a three-month extension of time; a copy of a credit card payment form authorizing the fee for a three-month extension of time; a third declaration of facts from Jean Claude Vieillefosse; and a copy of a date-stamped postcard receipt.

On 02 July 2001, the USPTO mailed a decision granting applicant's petition under 37 CFR 1.181 and dismissing applicant's renewed petition under 37 CFR 1.47. Specifically, it was noted that factual proof that the inventor refuses to execute the application and proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application had not been provided.

On 23 July 2001, applicant submitted a third renewed petition under 37 CFR 1.47(b).

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. As indicated in the decision mailed 27 July 2000, applicants have satisfied items (1), (3), (4), and (6) above.

In regard to item (2), the oral refusal (22 December 1998) referred to in the third declaration of Jean-Claude Vieillefosse was made before Mr. Dubois was presented with the application papers (30 December 1998) (see first declaration of facts of Mr. Vieillefosse, bottom of page 2). Additionally, it has not been established that Mr. Dubois failed to respond to the application papers sent to him on 30 December 1998. The renewed petition filed 23 July 2001 urges that the application papers were originally submitted to Mr. Dubois on November 9, 1998 with Miss Louvet's letter of that date. However, there is nothing in the translation of that letter which suggests that the application papers were sent on that date.

Regarding item (5), the third declaration of facts of Mr. Vieillefosse states that Mr. Vieillefosse "of his own personal knowledge knows that the invention in the above application was made by Mr. Dubois while employed by Hoechst Marion Roussel, the successor to Roussel Uclaf." However, this declaration is insufficient in that it provides no proof that the invention was actually invented during the period of Mr. Dubois's employment with Hoechst Marion Roussel on activities relating to his employment. The statement of Mr. Vieillefosse does not indicate any of the specific details surrounding the present invention of Mr. Dubois, e.g., the nature of the invention, when the invention was made, where the invention was made, the specific relationship

of the inventive activities of Mr. Dubois and his employment with Hoechst Marion Roussel. Rather, the declaration makes an assertion which is unsupported.

The renewed petition filed 23 July 2001 urges that it has been established that the invention was actually invented during the period of Mr. Dubois's employment with Hoechst Marion Roussel on activities relating to his employment because: (a) Mr. Dubois was employed by Roussel Uclaf at the time the priority document was filed; (b) Mr. Dubois was named as the inventor of the application in the documents sent to him; (c) Mr. Dubois' employment contract requires him to assign all inventions made during his period to the assignee; (d) Mr. Vieillefosse has stated that he knows Mr. Dubois is an inventor; and (e) Mr. Dubois has been designated as the inventor in the PCT filing.

-As to (a), the period of employment does not go to whether the invention was actually invented on activities relating to his employment.

-As to (b), naming Mr. Dubois as an inventor does not establish that the invention was actually invented during the period of Mr. Dubois's employment with Hoechst Marion Roussel on activities relating to his employment.

-As to (c), there are limitations on inventions which must be assigned. Attention is directed to the English translation of Exhibit B, Art. L. 611-7.

Art. L. 611-7. If the inventor is an employee, the right to the industrial property title, failing a contractual stipulation that is *more favourable to the employee*, is defined according to the following provisions:

1. Inventions made by the employee in the performance, either of a contract of employment comprising an inventive task *which corresponds to his actual duties*, or of studies and research with which he has been explicitly entrusted, belong to the employer. . . . (emphasis added)

Thus, the employee must have been performing an inventive task which corresponds to his actual duties or be performing studies and research with which he has been explicitly entrusted for the invention to belong to the employer.

-As to (d), as noted in the previous decision, this is an assertion which is unsupported.

-As to (e), the naming of Mr. Dubois as an inventor in the international application does not establish that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application.

Attention is directed to MPEP § 409.03(f) for information regarding proof of proprietary interest.

CONCLUSION

For the above reasons, applicants' renewed petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper

response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)", whichever is appropriate. No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.



Daniel Stemmer
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: 703-308-2066
Facsimile: 703-308-6459